

Remarks
In the Specification

Paragraphs [0012], [0013], [0016] and [0030] have been amended to correct minor spelling and typographical errors. Paragraph [0040] has been amended to correct an obvious omission of the word "coating". In paragraph [0012] the omitted term "titanate" was inserted and in paragraphs [0012], [0013] and [0016] the misspelled versions of the following terms: "diallyl"; "trineodecanoyl"; "sulfonyl"; "di(p-amino)"; and "allyl" were corrected.

In the Abstract

The original "Abstract" has been deleted and a revised Abstract submitted. In summary, the original Abstract has been amended to more particularly reflect the amended claims, e.g., that the coating composition is interposed between the polymeric coating and the substrate, and that it is in contact with the polymeric coating. Further, the Abstract now specifies that the coating composition is substantially free of photochromic material and the colloidal silica and/or alumina particles. Basis for these amendments can be found in the disclosure, examples and original claims. Such bases are discussed in more detail in the subsequent section regarding the amended claims.

In the Claims

Aside from grammatical and formatting revisions, the claims have been amended to recite that the adhesion enhancing coating composition is interposed between the polymeric coating and the substrate and that it is in contact with the polymeric coating. Further, the claims have been amended to recite that the adhesion enhancing coating composition is also substantially free of photochromic material. Basis for these amendments can be found in the disclosure, examples and original claims.

More particularly, the disclosure reports in paragraph [0004] (page 2) that there is a commercial need to produce adherent photochromic coatings on substrates in a rapid and economical manner. The Examples, e.g., example 13, show that photochromic coatings are applied to the adhesion enhancing coating composition. Paragraphs [0051] et seq. describes various photochromic polymeric coatings that can be applied to the adhesion enhancing coating composition. It is, therefore, implicit that the adhesion enhancing coating composition is substantially free of photochromic material because the photochromic material is present in the polymeric coating.

Claim 37 has been amended to more definitively describe the photochromic polymeric coating as comprising at least two "layers", one of which can be an outer layer, while another can be an inner layer. Such amendments are merely a restatement of the concept described in original claim 37.

Original claim 12 has been cancelled and re-submitted in independent form as new claim 51 in response to the objection of original claim 12 in the Office Action of November 3, 2004. Claims 13 and 14 have been amended to depend from new claim 51. These claims are now allowable, as reasoned by the Examiner on page 5 of the November 3 Office Action. Reconsideration and allowance of such claims are respectfully requested.

New claims 52 through 56 have been submitted to claim specific embodiments of Applicants' disclosure. Basis for these claims can be found in the original claims. More specifically, support for new claim 52 is found in original claim 6. Support for new claim 53 is found in original claims 7 and 9; while support for new claim 54 can be found in original claim 12. Support for new claim 55 can be found in original claims 15 and 16; while support for new claim 56 is found in original claims 28 and 44.

Restriction Requirements

Applicants' affirm the election with traverse to prosecute the invention of Group I, claims 1-18, that was made during a telephone conversation with the Examiner on June 29, 2004.

In the Office Action of November 3, 2004, restriction to one of the following inventions was required under 35 USC 121:

I. Claims 1-18, which are drawn to a coating composition, classified in class 106 subclass 287.16,

II. Claims 19-38, which are drawn to a process, classified in class 427, subclass 407.1+,

III. Claims 39-47, which are drawn to a coated article, classified in class 428, subclass 451+, and

IV. Claims 48-50, which are drawn to a laminated article, classified in class 359, subclass 241+.

Applicants respectfully traverse the foregoing restriction requirements.

It is argued in the restriction requirement that the claims of Groups I and II are related as product and process of use, and that the grouped claims are distinct, citing MPEP, section 806.05(h). It is further argued that the product of the claims of Group I can be used in a materially different process, such as a process of making a self-supporting film. This argument is not supported by the cited section of the MPEP.

Firstly, it is noted that the coating composition of the claims of Group I is the **same as** that used in the process of the claims of Group II. Hence, the process for using the product, as claimed, cannot be practiced with another materially different product. Hence, the product and process of Groups I and II are not distinct.

Secondly, the premise that the product can be used in a process to make a self-supporting film is not well founded. There is nothing within the disclosure to suggest that the coating composition can be used as a self-supporting film. Moreover, the patent cited in the Office Action; namely, US Patent 4,556,605, also does not support use of the photochromic film described there as a self-supporting film. The film of the '605 patent is for a photochromic **coating** composition for a synthetic resin ophthalmic lens and not for a self-supporting film.

The relationship of the claims of Groups I and II are related as combination and sub-combination. See section 806.05(c) of the MPEP. In such a relationship, two-way distinctness must be

demonstrated. Since the process claims of Group II require the particulars of the coating composition (the sub-combination of Group I), two-way distinctness cannot be shown. Therefore, the claims of Groups I and II are not distinct and should not be restricted. Reconsideration and recombination of the claims for purposes of examination are respectfully requested.

It is further argued in the restriction requirement that the claims of Group I and Group III are related as mutually exclusive species in an intermediate-final product relationship. Basis for this restriction is argued to be found in section 806.04(b), 3rd paragraph of the MPEP and 806.04(h). It is also submitted that the intermediate product can be used to make a self-supporting film. This restriction requirement is respectfully traversed.

Firstly, the subject matter of the claims of Groups I and III are not species under a common genus, and are therefore not independent inventions. Nor, as discussed above, is the intermediate product useful to make a self-supporting film. Hence, sections 806.04(b), 3rd paragraph and 806.04(h) does not apply to the Claims of Groups I and III. There is, of course, a relationship between the claims of Groups I and III, but this relationship is again one of combination and sub-combination, which requires two-way distinctness to validate a restriction requirement. See, the discussion submitted for the restriction requirement between the claims of Groups I and II. Reconsideration and recombination of the claims of Groups I and III are respectfully requested.

It is further argued that the claims of Groups I and IV are also properly restricted on the ground that they are related as mutually exclusive species in an intermediate-final product relationship, citing sections 806.04(b), 3rd paragraph and 806.04(h). The rebuttal arguments submitted in connection with the restriction requirement for the claims of Groups I and III are equally applicable here and need not be repeated. For those same reasons, it is submitted that the restriction requirement between the claims of Groups I and IV is not well founded. Reconsideration and recombination of these claims is respectfully requested.

The Office Action argues further that the subject matter of the claims of Groups II and III are related as process of making and

product made, citing section 806.05(f) of the MPEP. It is further argued that the product, as claimed, can be made by a materially different process, such as bonding the substrate to a partially cured polymeric coating followed by curing the adhesion enhancing coating composition. It is submitted that the proposed materially different process is not a realistic embodiment and therefore cannot be materially different. It is not seen how the substrate can be "bonded" to the polymeric coating with an interposed adhesion enhancing coating composition without also curing the interposed coating composition. Further, as amended, the claims of Groups II and III are not subject to the restriction theory submitted in the Office Action. Reconsideration and recombination of the claims of Groups II and III are respectfully requested.

The restriction requirement further argues that the subject matter of the claims of Groups II and IV are related as process of making and product made, citing section 806.05(f). This requirement is not well founded for the same reasons submitted above with respect to the restriction requirement for the claims of Groups II and III. Reconsideration and recombination of the claims of Groups II and III are respectfully requested.

Finally, it is argued in the restriction requirement that subject matter of claims III and IV are independent or distinct forms of each other because the subject matter of group III is directed to a coated article while the subject matter of group IV is directed to a laminated having a photochromic polymeric film covering. As amended, the claims of group IV now refer to a photochromic article rather than a laminate. Accordingly, the claims of group IV should be recombined with those of group III. Reconsideration is respectfully requested.

Applicants submit that subject matter of all four groups of claims can be searched at one time without a serious burden on the part of the Examiner. Indeed, a search of the subject matter of the claims of group I requires a search in all of the classes and subclasses cited in the Office Action. The Patent Office has already acknowledged that such a search is required and has been done in the past. See, the claims of Tanaka et al. U.S. Patent 4,291,098. Included in the Tanaka et al. patent are claims directed

to a coating composition (Applicants' Group I), a method of using the coating composition (Applicants' Group II) and an article having a cured coating of the composition (Applicants' Group III and IV)

As specified in MPEP 803, if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. Here, the claims of Groups I through IV have been shown not to be independent and/or distinct. Moreover, an examination of all of such claims would not constitute an undue burden because such an examination is commonplace, as shown by the issuance of the '098 patent to Tanaka et al. Therefore, all of the claims now pending in this application should be examined together.

Reconsideration and withdrawal of the restriction requirement are respectfully requested.

Response to the Rejection under U.S.C. §102

Claims 1-11 and 15-18 have been rejected under 35 USC 102(b) as being anticipated by US Patent 4,556,605 to Mogami et al. This rejection is respectfully traversed with respect to all of the presently pending claims, including the claims withdrawn from consideration.

Mogami et al. (US Patent 4,556,605) is directed to a photochromic synthetic ophthalmic lens made of a synthetic resin lens that is coated with a photochromic hard coat formed from a hydrolyzed silane and a photochromic material. As stated in column 4, lines 22-28 of the '605 patent, the photochromic hard coat provides scratch resistance, chemical resistance, solvent resistance, impact resistance and good tintability. This coating is designed to be the outer coating on a lens substrate and there is no contemplation of applying further coatings to this photochromic coating in the disclosure of the patent. In contrast, the enhanced adhesion coating of Applicants' claims is a coating applied to a substrate for the express purpose of enhancing the adhesion of a subsequently applied polymeric coating, i.e., the enhanced adhesion

coating is interposed between the substrate and the polymeric coating, e.g., the photochromic coating.

Moreover, Applicants have amended their claims to reflect that the coating composition is substantially free of photochromic material, which distinguishes their coating composition from those described by Mogami et al in the cited '605 patent.

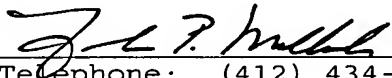
Applicants submit that the Mogami et al patent does not anticipate Applicants' claimed invention. Reconsideration and withdrawal of this rejection is respectfully requested.

Applicants submit that claims 1-50 are in now in condition for allowance and therefore, respectfully request reconsideration of and an early allowance of these claims.

In the event that the Examiner considers any matter unresolved, the Examiner is invited to phone Applicants' representative at the number indicated below in order to expedite the resolution of any such matter.

Respectfully submitted,

FRANK P. MALLAK
Registration No. 36,590
Agent for Applicant


Telephone: (412) 434-3709
Facsimile: (412) 434-4292

Pittsburgh, Pennsylvania

March 2, 2005